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NOTICE OF ALLOWANCE AND FEE(S) DUE

020322 **HIS** 7590

10/18/2004

SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

RECEIVED

OCT 20 2004

SNELL & WILMER

EXAMINER

ABDI, KAMRIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/18/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,628	03/10/2000	Frederic Petit	10655.7500	5109

TITLE OF INVENTION: METHODS AND APPARATUS FOR AUTHENTICATING THE DOWNLOAD OF INFORMATION ONTO A SMART CARD

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1370	\$0	\$1370	01/18/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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PTOL-85 (Rev. 09/04) Approved for use through 04/30/2007.



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Determination of Patent Term Extension under 35 U.S.C. 154 (b) (application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 0 day(s). Any patent to issue from the above-identified application will include an indication of the 0 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability	Application No.	Applicant(s)	
	09/522,628	PETIT, FREDERIC	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6 August 2004.
2. ☒ The allowed claim(s) is/are 19, 27 and 34-36.
3. ☒ The drawings filed on 10 March 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ Including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

U.S. Patent and Trademark Office
PTOL-37 (Rev. 1-04)

Notice of Allowability

JAMES P. THORNTON
SEPTIMUS PATENT EXAMINER

Part of Paper No./Mail Date 20040915

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DETAILED ACTION

1. The text prior office actions are incorporated in this office action by reference. Applicant has filed an amendment/argument after an office action mailed on 6 April 2004, which has been entered.

- Claim 1 is amended.
- Claims 1-19, 20-26, 28-33, and 37 are canceled.
- No claim has been added.
- Claims 19, 27, and 34-36 have been allowed.

Examiner's Amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

3. Authorization for this examiner's amendment was given in a telephone interview with attorney Daniel R. Pote on 15 September 2004.

The examiner under agreement by the attorney representing the applicant has amended independent claims 19 and 34.

The claim in the application has been amended as follow:

19. A method for an information owner to download software to an information device over a network, wherein said information device comprises a smart card, and said method comprises the steps of:
- a. the information owner delegating to a third party, download of said software from a server associated with said third party to the information device, wherein said Information device is capable of downloading new instruction, update existing instructions, and overwriting existing instructions;
 - b. the Information device computing an acknowledgment of said download of said software, wherein said acknowledgment includes a digital signature created via public key encryption;

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c. the information device sending said computed acknowledgment to the information owner via said network; and

d. the information owner verifying the computed acknowledgment, wherein only the information owner can verify the computed acknowledgement.

34. A system for allowing a smart card issuer to securely delegate to a third party the download of an applet to a smart card over a network, said system comprising:

an external device associated with said third party and having said applet resident thereon, said external device capable of transferring said applet to said smart card, wherein said applet is associated with said issuer and said applet is transferred by said third party as delegated by said issuer, said information device capable of downloading new instructions, update existing instructions, and overwriting existing instructions;

said smart card includes instructions configured to initiate a public-key acknowledgement process that produces a digital signature responsive to successful transfer of said applet and utilizing a cryptographic key stored on said smart card, and send said digital signature to said issuer for validation by said issuer, wherein only the issuer can validate said acknowledgement.

Allowable Subject Matter

4. Claims 1-14 are allowed over the prior art of record.

The following is an examiner's statement of reason for allowance:

5. The closest prior art of record is U.S. Patent No. 5,923,884 to Patrice Peyret et al. and U.S. Patent No. 6,105,008 to Vigil M. Davis et al. provides general methods and systems for upgrading or installing new application software or data on a smart card and validating such transaction. Peyret teaches the download of an applet into a smart card. Davis teaches general practice of control and verifying load commands and load success by providing a system for downloading data into a smart card and creating and acknowledgment that is verifiable by the server. What distinguishes the current claims over the art of record is that the software applet is distributed by a third party which has been delegated the tasks of downloading new instruction, update existing instructions, and overwriting existing

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instructions in a smart card. Once the successful task has been accomplished, the smart card internally and without the intervention of the third party system, generates an acknowledgment that is forwarded to the issuer for verification of the successful downloading new instruction, update existing instructions, and overwriting existing instructions assigned to the third party has been accomplished at the smart card.

6. The closest foreign prior art of record is European Patent Application EP 0949 595 A2 to Jack C. Pan, and the NPL cited in the application, titled "A New High-security, Multi-Application Smart Card Jointly Developed by Bull and Philips", by P. Schnable, 1991.

7. In regards to claims 19 and 34, the closest prior art of record when taken either individually or in combination with other prior art of record fails to teach or suggest the step of a delegation of downloading new instruction, update existing instructions, and overwriting existing instructions in a smart card to a third party and verification of successful accomplishment of such tasks by the issuer without any intervention by the delegated party and only by the virtue of internal processes of the smart card for generating such encrypted acknowledgment.

8. Claim 27 is dependent upon claim 19 and claims 35-36 are dependent upon claim 34, thus they all have the limitations of claims 19 and 34, therefore, they are allowable for that same reason stated above.

Conclusion

9. Any comments considered necessary by the applicant must be submitted no later than the payment of the issues fee and, to avoid processing delays, should preferably accompany the issue fee. Such submission should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

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Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
September 16, 2004**